

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: K. OZAKI et al

Application No.: 10/724,360

Filed: December 1, 2003

For: METHOD OF MAKING SHEET ELECTRODE...

Art Unit: 1731

Examiner: M. Halpern

Washington, D.C.

Atty.'s Docket: OZAKI=8

Confirmation No.: 8079

Date: June 9, 2005



Customer Service Window, Mail Stop Amendment
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, 401 Dulany Street
Alexandria, Virginia 22314

Sir:

Transmitted herewith is a REPLY TO RESTRICTION REQUIREMENT in the above-identified application.

☐ Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

☒ No additional fee is required.

☐ The fee has been calculated as shown below:

(Col. 1)			(Col. 2)		(Col. 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY		
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR		PRESENT EXTRA EQUALS	RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE	
TOTAL	*	MINUS	** 20		0	x 25	\$		x 50	\$	
INDEP.	*	MINUS	*** 3		0	x 100	\$		x 200	\$	
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM						+ 180	\$		+ 360	\$	
						ADDITIONAL FEE TOTAL		\$	OR	TOTAL	\$

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

☐ First - \$ 60.00

☐ Second - \$ 225.00

☐ Third - \$ 510.00

☐ Fourth - \$ 795.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

☐ First - \$ 120.00

☐ Second - \$ 450.00

☐ Third - \$ 1020.00

☐ Fourth - \$ 1590.00

Month After Time Period Set

☐ Less fees (\$) already paid for month(s) extension of time on .

☐ Please charge my Deposit Account No. 02-4035 in the amount of \$.

☐ Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$.

☐ A check in the amount of \$ is attached (check no.).

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s)

By:

Shendan Neimark
Shendan Neimark
Registration No. 20,520

Facsimile: (202) 737-3528
Telephone: (202) 628-5197



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: OZAKI=8

In re Application of:)	Confirmation No.: 8079
)	
Kouki OZAKI et al)	Art Unit: 1731
)	
Appln. No.: 10/724,360)	Examiner: M. Halpern
)	
Filing Date: December 1, 2003)	June 9, 2005
371(c) Date:)	
)	
For: METHOD OF MAKING SHEET)	
ELECTRODE FOR ELECTRIC...)	

REPLY TO RESTRICTION REQUIREMENT

Customer Service Window, Mail Stop Amendment
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

This will acknowledge and reply to the restriction requirement Office Action mailed May 11, 2005.

The present applicants have claimed benefit under 35 U.S.C. 119 of their application filed in Japan on November 29, 2002; and applicants filed a certified copy of the priority document at the time of filing the present application on December 1, 2003. Accordingly, applicants respectfully request the PTO to acknowledge receipt of applicants' papers filed under Section 119.

Restriction has been required between what the PTO deems to be two (2) patentably distinct inventions. As applicants must make an election even though the requirement is traversed, applicants hereby respectfully and provisionally elect Group I, presently only claims 1 and 2, directed to a method, without prejudice and with traverse.

The requirement is predicated on the assumption that "the apparatus as claimed can be used to practice another and materially different process [, namely] the apparatus can be used ... [in] making a tobacco sheet." The conclusion reached by the PTO in this regard can be reached only if one ignores part of the apparatus claims, including the preamble of claims 3 and 4 which recite a "roller rolling machine making a sheet electrode". Thus, the apparatus "**as claimed**" cannot be used to practice a different process such as making a tobacco sheet, and certainly cannot be used to practice a "**materially different**" process.

Moreover, it should be abundantly clear that the method and apparatus are closely tied together and are used in conjunction with one another. Even if the restriction requirement is deemed proper, restriction is discretionary with the examiner, and in a case such as the present case (where the method and apparatus are so closely tied together),

Appln. No. 10/724,360
Reply dated June 9, 2005
Reply to Office Action of May 11, 2005

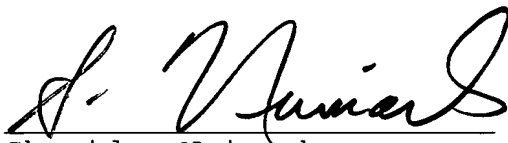
the examiner should use his discretion and examine both groups together.

In addition, withdrawal of the requirement and examination of both method and apparatus together would also be consistent with the second paragraph of MPEP 803, which **requires** search and examination of an entire application, even when the restriction requirement is correct, if to do so would not constitute a "serious burden". In the present case, a complete search of the method will certainly require a search of the apparatus as well; and once this is done, it would not be a serious burden to examine the two apparatus claims 3 and 4 along with the elected method claims.

Withdrawal of the requirement and examination of all the claims are accordingly respectfully requested.

Applicants now respectfully await the results of a first examination on the merits.

Respectfully submitted,
BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By: 
Sheridan Neimark
Registration No. 20,520

SN:jec
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\BN\S\sato\Ozaki8\Pto\ReplyRestrtn 09 June 05.doc